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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,834	09/05/2003	Terrence Paul McFadden	9356	7069

27752 7590 08/15/2008

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EXAMINER	
JARRETT, SCOTT L	

ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
08/15/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/655,834	MCFADDEN, TERRENCE PAUL	
	Examiner	Art Unit	
	SCOTT L. JARRETT	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 June 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's amendment filed June 3, 20008. Applicant's amendment amended claims 1-23 and added new claims 24-31. Currently Claims 1-31 are pending.

This action has been made Non-Final in order to raise a new grounds of rejection under 35 U.S.C. 101.

Response to Amendment

2. The Objections to claims 11, 19 and 21-23 are withdrawn in response to Applicant's amendments to claims 11, 19 and 21-23.

The 35 U.S.C. 112(2) rejection of claim 20 is withdrawn in response to Applicant's amendments to claim 20.

Response to Arguments

3. Applicant's arguments filed June 3, 2008 have been fully considered but they are not persuasive. Specifically Applicant's argue that the prior art of record fails to teach of suggest monitoring one or a plurality of internet websites of a selected organization for occurrences of a selected expression wherein the monitoring comprises monitoring the embedded links and documents associated with the websites (Last Paragraph, Page 9) as new amended independent claims 1, 19, 20 and 21 recite.

In response to Applicant's argument that the prior art of record, specifically Yoo et al., U.S. Patent No. 7,146,416, fails to teach or suggest monitoring one or a plurality

of internet websites of a selected organization for occurrences of a selected expression wherein the monitoring comprises monitoring the embedded links and documents associated with the websites the examiner respectfully disagrees.

Yoo et al. teach a system and method for analyzing the usage of an expression comprising: monitoring one or a plurality of internet websites of a selected organization (Column 4, Lines 28-43; Column 6, Lines 25-35, 55-59; Column 14, Lines 9-13) for occurrences of a selected expression wherein the monitoring comprises monitoring the embedded links (hyperlinks, clickstream) and documents (web pages, chat, media files, server logs, purchase records, database records etc.) associated with the websites (Column 3, Lines 10-15, 56-60; Column 4, Lines 8-14; Column 6, Lines 60-68; Column 10, Lines 17-23; Column 13, Lines 60-65; Column 14, Lines 9-13; Table 1).

In response to applicant's Applicant(s) attempt at traversing the Official Notice findings as stated in the previous Office Action (Remarks Paragraph 2, Page 10) is inadequate. Adequate traversal is a two step process. First, Applicant(s) must state their traversal on the record. Second and in accordance with 37 C.F.R. 1.111(b) which requires Applicant(s) to specifically point out the supposed errors in the Office Action, Applicant(s) must state why the Official Notice statement(s) are not to be considered common knowledge or well known in the art.

In this application, while Applicant(s) have met step (1), Applicant(s) have failed step (2) since they have failed to argue why the Official Notice statement(s) are not to be considered common knowledge or well known in the art. Because Applicant(s)'

traversal is inadequate, the Official Notice statement(s) are taken to be admitted as prior art. See MPEP 2144.03.

Therefore it is noted that since Applicant's attempt to traverse the officially cited fact(s) in the previous office action(s) is inadequate those statements as presented are herein after prior art. Specifically it has been established that it was old and well known in the art at the time of the invention to convert from audio content to textual content wherein speech to text conversion enables one to more readily analyze, search and perform other data operations on the converted speech (text).

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-31 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claims 1-31, the claims, as currently recited, appear to be directed to a compilation of data without any tangible result and are therefore deemed to be non-statutory while the compilation of data may have some real world value (i.e. utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any "acts" which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diamond v. Diehr, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations

preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (Abele, 684 F.2d 902, 907, 214 USPQ 682, 687(CCPA 1982)). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under 35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2dat 1452 and State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In Warmerdam the abstract idea of a data structure became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claims 1-31 merely recite a system/method for collecting and analyzing (counting) the usage of an expression (i.e. useful and concrete). While the invention may be concrete and/or useful, there does not appear to be any tangible result.

Further regarding Claims 1-18 and 20, based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least Gottschalk v. Benson, 409 U.S. 63, 71 (1972)).

A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here Claims 1-18 and 20 fail to meet the above requirements because they are not tied to another statutory class of invention.

Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Comiskey, 499 F.3d at 1380 (citing In re Grams, 888 F.2d 835, 839-40 (Fed. Cir.1989)). Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-15, 17-24, 26, 28, and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoo et al., U.S. Patent No. 7,146,416.

Regarding Claims 1, 19, 20 and 21 Yoo et al. teach a system and method for analyzing usage of an expression (phrase, term, word, keyword, item, symbol, number, ad, content, topics, categories, etc.) comprising (Figures 1, 3B, 5, 7, 8):

- monitoring one or a plurality of internet websites of a selected organization (Column 4, Lines 28-43; Column 6, Lines 25-35, 55-59; Column 14, Lines 9-13) for occurrences of a selected expression wherein the monitoring comprises monitoring the embedded links (hyperlinks, clickstream) and documents (web pages, chat, media files, server logs, purchase records, database records etc.) associated with the websites (Column 3, Lines 10-15, 56-60; Column 4, Lines 8-14; Column 6, Lines 60-68; Column 10, Lines 17-23; Column 13, Lines 60-65; Column 14, Lines 9-13; Table 1; Figure 5).

- gathering and storing predetermined attributes of each occurrence of the expression (Step 2, Column 5; Column 7, Lines 25-68; Figures 3B, 8);

- repeating the monitoring, gathering, and storing at a subsequent time interval (e.g. trends over time; Column 14, Lines 5-60; Figures 4, 6, 8-11); and

- compiling and storing the number of occurrences of the expression in the organization as a function of time and storing the resulting compilation in a user accessible medium (Section 2, Columns 7-8; Column 14, Lines 5-60; Column 5, Lines 1-15; Column 12, Lines 15-57; Figure 1, Element 106, Search Log/Page Hit Records; Figures 5, 7-9).

Yoo et al. further teach a system and method for analyzing usage of an expression comprising:

- a first data storage system (component, module, code, subsystem, objection, etc.) comprising an organization within a time interval (Column 13, Lines 30-68; Column 12, Lines 45-56; Figures 1, 5, 7);

- monitoring the organization for occurrences of the expression via a monitoring tool (Column 6, Lines 48-68; Section 2, Columns 7-8; Figure 1, 7);

- storing each occurrence of the expression and its predetermined attributes in a second data storage subsystem (Column 12, Lines 45-56; Column 13, Lines 30-68; Figures 1, 5, 7);

- compiling and storing the number of occurrences of the expression in the organization as a function of time in a user accessible medium (Column 14, Lines 5-60; Section 41, Column 15; Figures 1, 5, 7-14).

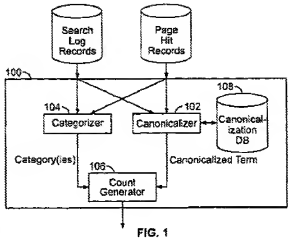
Search Log Records
Page Hit Records
100
108
104
Categorizer
102
Canonicalizer
Canonical-ization DB
Category(ies)
Canonicalized Term
106
Count Generator

FIG. 1

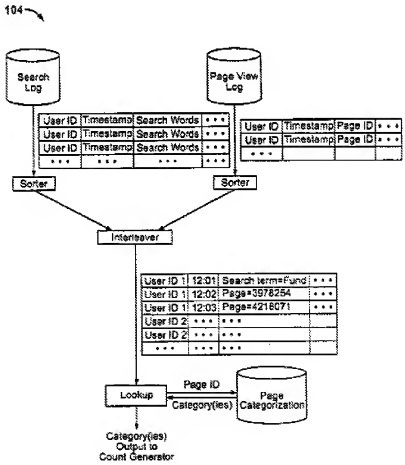
104
Search Log
Page View Log
User ID
Timestamp
Search Words
Page ID
Sorter
Sorter
Interleaver
User ID 1 12:01 Search term=Fund
User ID 1 12:02 Page=3578254
User ID 1 12:03 Page=4218071
User ID 2
User ID 2
Lookup
Page ID
Category(ies)
Page Categorization
Category(ies) Output to Count Generator

FIG. 5

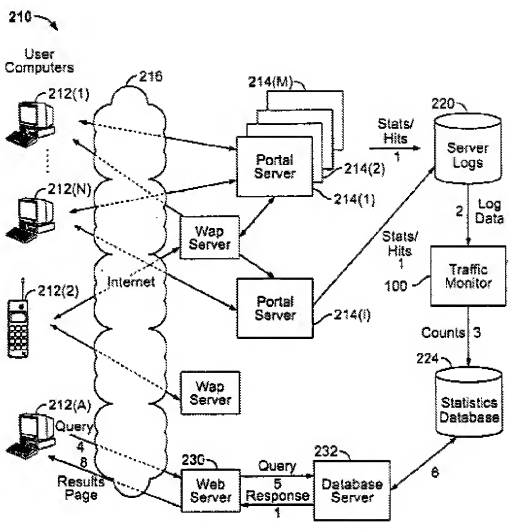
210
User Computers
212(1)
212(N)
212(2)
212(A)
216
Internet
214(M)
214(2)
214(1)
214(I)
Portal Server
Wap Server
Wap Server
Stats/ Hits
1
220
Server Logs
2
Log Data
Stats/ Hits
1
Traffic Monitor
100
Counts
3
224
Statistics Database
Query
4
8
Results Page
230
Web Server
Query
5
Response
1
232
Database Server
6

FIG. 7

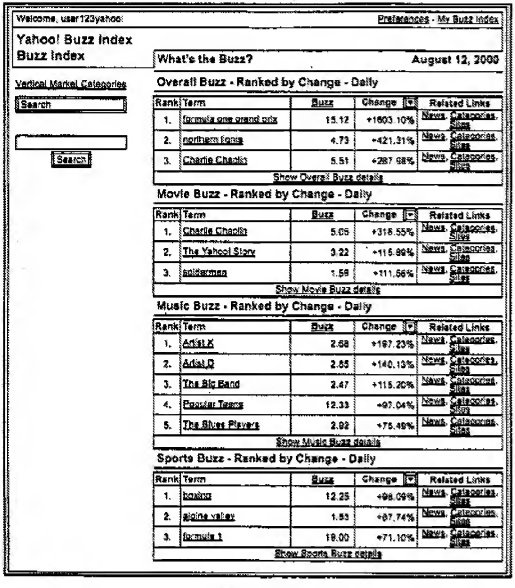

FIG. 9

Regarding Claims 2-4 Yoo et al. teach a system and method for analyzing usage of an expression further comprising monitoring a plurality of organizations and wherein the number of occurrences of the expression and less than or all of the plurality of organizations (Column 14, Lines 5-60; Column 12, Lines 15-57; Figures 9-10).

Regarding Claims 5-6 Yoo et al. teach a system and method for analyzing usage of an expression wherein the expression comprises a term or phrase or textual content (Abstract; Column 4, Lines 28-28; Figures 8-10).

Regarding Claim 7 Yoo et al. teach a system and method for analyzing usage of an expression wherein the organization further comprises monitoring purchased data *or* internal databases (database records, server logs, purchase data, etc.; Column 3, Lines 57-60; Column 12, Lines 15-57; Column 13, Lines 60-65; Figures 1, 5, 7, 9-10).

Regarding Claim 8 Yoo et al.teach a system and method for analyzing usage of an expression wherein prior to monitoring the organization is assembled in a data storage system (Column 12, Lines 15-57; Figure 1, 5, 7).

Regarding Claims 9-10 Yoo et al. teach a system and method for analyzing usage of an expression wherein repeating occurs at a plurality of subsequent time internals or wherein the time interval is a day (Column 8, Lines 65-68; Figures 4-6, 9-10).

Regarding Claim 11 Yoo et al. teach a system and method for analyzing usage of an expression wherein the predetermined attributes comprise time-stamping, website URL, or company information (Column 10, Lines 40-50; Figures 3B, 5, 8-11).

Regarding Claim 12 Yoo et al. teach a system and method for analyzing usage of an expression wherein the occurrences of the expression and predetermined attributes are stored in a data storage system (Column 12, Lines 15-57; Figures 1, 5, 7).

Regarding Claim 13 Yoo et al. teach a system and method for analyzing usage of an expression further comprising analyzing the resulting compilation of occurrences of the expression to determined a trend (Column 14, Lines 5-68; Column 15, Lines 5-52; Figures 11, 12B, 14).

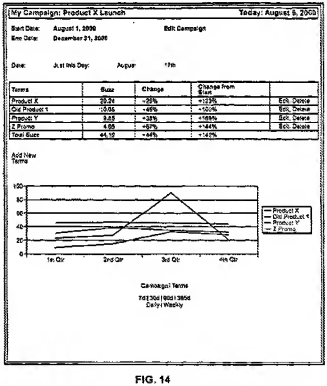

FIG. 14

Regarding Claims 14-15 and 23 Yoo et al. teach a system and method for analyzing usage of an expression further comprising outputting the stored compilation to a user interface and/or display a graphical analysis resulting from the compilation (e.g. reports; Column 13, Lines 30-42; Column 15, Lines 5-52; Figures 8-14).

Regarding Claims 17 and 22 Yoo et al. teach a system and method for analyzing usage of an expression further comprising filtering the occurrences of the expression and predetermined attributes (Column 11, Lines 14-24; Column 14, Lines 52-50; Column 15, Lines 35-45).

Regarding Claim 18 Yoo et al. teach a system and method for analyzing usage of an expression further comprising providing access to the stored predetermined attributes of the occurrences associated with a selected timed interview for display on a user interface. (SEE CLAIM 14)

Regarding Claims 24, 26, 28 and 30 Yoo et al. teach a system and method for analyzing the usage of an expression wherein internet website monitoring comprises monitoring all embedded links and documents associated with the website (Column 14, Lines 8-15).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 16, 25, 27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoo et al., U.S. Patent No. 7,146,416 as applied to claim1-15 and 17-23 above, and further in view of official notice.

Regarding Claim 16 Yoo et al. does not expressly teach converting from audio content to textual content as claimed.

Official notice is taken that converting from audio content to textual content is old and well known wherein speech to text conversion enables one to more readily analyze, search and perform other data operations on the converted speech (text).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for analyzing usage of an expression as taught by Yoo et al. would have benefited from converting audio content to textual content thereby making it easier for one to analyze and/or store the original audio content in view of the teachings of official notice.

Regarding Claims 25, 27, 29 and 31 Yoo et al. teach a system and method for analyzing the usage of an expression wherein the internet website monitoring comprises monitoring a plurality of internal and external databases/data (Column 13, Lines 60-64; Figure 1, 7; including a demographic database, Claim 12) as well as plurality of distributed servers/systems (Column 4, Lines 28-38; Column 6, Lines 33-35).

Yoo et al. does not expressly teach limiting the databases (data) analyzed to purchased databases as claimed.

Official notice is taken that purchasing databases for the purposes of analyzing them (e.g. direct marketing databases for analyzing and conducting direct marketing campaigns) are old and very well known. An example of such 'purchase data' include the purchase (subscription) to demographic consumer databases by companies for use in market analysis or consumer marketing.

Further support for this officially cited fact can be found in at least Hobbs, U.S. Patent No. 6,523,022. Hobbs teaches a system and method for analyzing a the usage of an expression in a plurality of data sources including purchased databases (Background of the Invention, Column 2, Lines 26-41).

Further it is noted that these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the

same regardless of the whether or not the system/method analyzed data for which a fee is paid. Further, the structural elements remain the same regardless of the whether or not the system/method analyzed data for which a fee is paid. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.*

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Leshem et al., U.S. Patent No. 6,470,383, teach a system and method for analyzing usage one or a plurality of websites comprising monitoring one or a plurality of internet web sites wherein the monitoring comprises monitoring (all) the embedded links and documents associated wit the websites.

- Snyder, U.S. Patent No. 6,643,641, teach a system and method monitoring and analyzing one or a plurality of websites wherein the monitoring comprises monitoring all embedded links and documents associated with the websites.

- Golding et al., U.S. Patent No. 6,640,218, teach a system and method for analyzing the usage of an expression through the monitoring of one or a plurality of internet websites.

- Jellum et al., U.S. Patent No. 6,915,482, teach a monitoring a plurality of expressions wherein the monitoring comprises monitoring a one or a plurality of internet websites for the usage of the expression wherein the monitoring further comprises monitoring embedded links and documents associated with the websites.

- Rassool et al., U.S. Patent No. 7,043,473, teach a system and method for analyzing the usage of an expression (e.g. media) comprising monitoring one or a plurality of Internet websites of a selection organization for occurrences of a selected expression within a time interval, wherein the monitoring comprises monitoring all embedded links and documents (media) associated with the websites.

- Swannack et al., U.S. Patent Publication No. 2002/0087515, teach a system and method monitoring the usage of an expression of one or a plurality of selected internet websites wherein monitoring comprises monitoring all embedded links and documents associated with the websites.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Van Doren Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3623